



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/197,506	11/23/1998	RICHARD GIOSCIA	SOA-246	1334

7590 02/27/2004

RONALD P KANANEN
RADER FISHMAN & GRAUER
THE LION BUILDING
1233 20TH STREET N W SUITE 501
WASHINGTON, DC 20036

EXAMINER

CHOW, CHARLES CHIANG

ART UNIT	PAPER NUMBER
----------	--------------

2685

DATE MAILED: 02/27/2004

51

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/197,506

Applicant(s)

GIOSCIA ET AL.

Examiner

Charles Chow

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12/2/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-7,10,13-17,19-22,24,25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,10,13-17,19-22,24,25 and 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

*Office Action for amendment
Received on 12/02/2003*

Claim Rejections - 35 USC§ 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-2, 5-7, 10, 13, 15-17, 19, 22, 24-25, 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz (US RE37,131E) in view of Bernard et al. (US 5,918,213).

Regarding **claim 1**, Mankovitz teaches a method of providing listeners with Information about audio programming being digitally broadcast (the system for broadcasting audio music and lyrics, for listening and purchasing at a later time (Fig. 10, col. 1, lines 16-19, col. 1, line 63 to col. 2, line 7; col. 5, lines 11-43) having combining data signal carrying contextual information about audio program with audio signal carrying said audio program (the transmitting audio musical selections and auxiliary data and the text message is transmitted during the transmitting of musical selection, col. 3, lines 15-25, col. 2, lines 43-56), the musical selection is lyrics music (col. 2, lines 22-23; col. 22, line 66 to col. 3, line 29), the receiving combined data and audio signal for reproducing using transducer loudspeaker, the decoding and displaying text message (col. 2, lines 26-31; col. 5, lines 21-24) on display 106 (col. 10, line 57). Mankovitz teaches the storing at least portion of contextual information onto a storage (multiple text message may be stored and recalled in col. col. 2,

Art Unit: 2685

lines 32-42), the purchasing of the album at a later time (col. 2, lines 4-7). It is well known in the technology that the removable storage, cassette, can be used with FM radio receiver.

Mankovitz does not clearly teach the listening of the audio music for a desired selection before the transmitting of purchase order.

Bernard et al. (Bernard) teaches the evaluation of music prior to purchasing (abstract, Fig. 13, Fig. 17, Fig. 19-21), allowing customer to listen a sampler cuts from music tracks (abstract), the music samples includes two categories, single song teasers and a string of separate samples of songs from single album (col. 28, lines 6-15, Fig. 9), for selecting different music samples to listen first, then purchase the selected songs (col. 34, line 27 to col. 35, line 56). Bernard teaches an improved efficient purchasing system by allowing user to preview the music sample before purchasing, convenient and economically (col. 2, line 52 to col. 3, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Mankovitz, and include Bernard's music sample preview prior to purchase, such that the music could be efficiently, economically, distributed to the user by allowing user's previewing samples to promote the product sales.

Regarding **claim 2**, Mankovitz taught above in claim 1 the combined data and audio signals as a digital radio signal (pulses in Fig. 3; the broadcast of the digital message in col. 9, lines 48 and line 65; generating and transmitting data in col. 27, lines 22-23; the transmitting substantially concurrently in col. 5, lines 16-19).

Regarding **claim 5**, Mankovitz taught above in claim 1 the receiver for receiving combined audio signal and contextual information (col. 2, lines 26-31), the receiver for receiving

Art Unit: 2685

broadcast signal (in claim 1 above), the processor for separating audio and data with speaker 95/98 (Fig. 4, the AM detector 84, the left channel audio amp. 92, and demodulator 118, processor 120 outputs music 150 to D/A 148), the multiple text message may be stored and recalled in col. 2, lines 32-42), the purchasing of the album at a later time (col. 2, lines 4-7, col. 5, lines 26-35). It is well known in the technology that the removable storage, cassette, can be used with FM radio receiver.

Mankovitz does not clearly teach a transceiver, a connection between processor and service provider to identify particular audio programming to service provider, the user input device to place purchase of particular program,

Bernard teaches the service provider at interface units 104 for providing music shopping and functionality of the automatic purchasing, the order fulfillment center (Fig. 1, col. 21-63, Fig. 38-39, Fig. 9, voice response unit VRU). Bernard teaches the transmitting user purchase order to order fulfillment center (Fig. 4, 436) which is obviously indicating the purchasing system comprised a transmitter of the transceiver. Bernard teaches the user input device to place purchase of particular program, by using keystrokes (col. 35, lines 35-65), the "just press 6" to automatically placing the ordering of the music hear (col. 34, lines 27-32).

Bernard teaches an improved efficient purchasing system by allowing user to preview the music sample before purchasing, convenient and economically (col. 2, line 52 to col. 3, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Mankovitz, and include Bernard's music sample preview prior to purchase, such that the music could be efficiently, economically, distributed to the user by allowing user's previewing samples to promote the product sales.

Art Unit: 2685

Regarding **claims 6, 16**, Mankovitz teaches the display 106 for contextual information, with display 106 (Fig. 4).

Regarding **claims 7, 17, 24**, Mankovitz teaches the user input device for controlling display of contextual information on display, the user input device up/down 102 (Fig. 4), the MEM 116, the delete 138, the recall 136, save 128, to processor 120 to indirectly changes the context, station 104.7 MHz, Billy Jean, Michael Jackson, thriller, displayed on 106

Regarding **claim 10**, Mankovitz teaches a user input, "SAVE" 128 (Fig. 4) for storing contextual information to memory.

Regarding **claim 13**, Mankovitz teaches the storing of musical audio selection along with text message (col. 2, lines 35-36).

Regarding **claim 15**, Mankovitz taught above in claim 1 the receiver for receiving combined audio signal and contextual information (col. 2, lines 26-31), the receiver for receiving broadcast signal (in claim 1 above), the processor for separating audio and data with speaker 95/98 (Fig. 4, the AM detector 84, the left channel audio amp. 92, and demodulator 118, processor 120 outputs music 150 to D/A 148), the multiple text message may be stored and recalled in col. col. 2, lines 32-42), the purchasing of the album at a later time (col. 2, lines 4-7, col. 5, lines 26-35). It is well known in the technology that the removable storage, cassette, can be used with FM radio receiver.

Mankovitz does not clearly teach a transceiver, a connection between processor and service provider to identify particular audio programming to service provider, the user input device to place purchase of particular program,

Art Unit: 2685

Bernard teaches the service provider at interface units 104 for providing music shopping and functionality of the automatic purchasing, the order fulfillment center (Fig. 1, col. 21-63, Fig. 38-39, Fig. 9, voice response unit VRU). Bernard teaches the transmitting user purchase order to order fulfillment center (Fig. 4, 436) which is obviously indicating the purchasing system comprised a transmitter of the transceiver. Bernard teaches the user input device to place purchase of particular program, by using keystrokes (col. 35, lines 35-65), the "just press 6" to automatically placing the ordering of the music hear (col. 34, lines 27-32).

Bernard teaches an improved efficient purchasing system by allowing user to preview the music sample before purchasing, convenient and economically (col. 2, line 52 to col. 3, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Mankovitz, and include Bernard's music sample preview prior to purchase, such that the music could be efficiently, economically, distributed to the user by allowing user's previewing samples to promote the product sales.

Regarding **claim 19**, Bernard teaches the purchasing a recording of audio programming by transmitting at least portion of contextual information, artist name, catalog number, to identify audio program (col. 34, lines 27-65).

Regarding **claim 22**, Mankovitz teaches a receiver for receiving a broadcast signal which is an signal and a data signal combined, a method of providing listeners with Information about audio programming being digitally broadcast (the system for broadcasting audio music and lyrics, for listening and purchasing at a later time (Fig. 10, col. 1, lines 16-19, col. 1, line 63 to col. 2, line 7; col. 5, lines 11-43) having combining data signal carrying contextual information about audio program with audio signal carrying said audio program (the

Art Unit: 2685

transmitting audio musical selections and auxiliary data and the text message is transmitted during the transmitting of musical selection, col. 3, lines 15-25, col. 2, lines 43-56), the musical selection is lyrics music (col. 2, lines 22-23; col. 22, line 66 to col. 3, line 29), the receiving combined data and audio signal for reproducing using transducer loudspeaker, the separating, decoding and displaying text message (col. 2, lines 26-31; col. 5, lines 21-24) on display 106 (col. 10, line 57). Mankovitz teaches the storing at least portion of contextual information onto a storage (multiple text message may be stored and recalled in col. col. 2, lines 32-42), the purchasing of the album at a later time (col. 2, lines 4-7). It is well known in the technology that the removable storage, cassette, can be used with FM radio receiver.

Bernard teaches the service provider at interface units 104 for providing music shopping and functionality of the automatic purchasing, the order fulfillment center (Fig. 1, col. 21-63, Fig. 38-39, Fig. 9, voice response unit VRU). Bernard teaches the transmitting user purchase order to order fulfillment center (Fig. 4, 436) which is obviously indicating the purchasing system comprised a transmitter of the transceiver. Bernard teaches the user input device to place purchase of particular program, by using keystrokes (col. 35, lines 35-65), the "just press 6" to automatically placing the ordering of the music hear (col. 34, lines 27-32).

Bernard teaches an improved efficient purchasing system by allowing user to preview the music sample before purchasing, convenient and economically (col. 2, line 52 to col. 3, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Mankovitz, and include Bernard's music sample preview prior to purchase, such that the music could be efficiently, economically, distributed to the user by allowing user's previewing samples to promote the product sales.

Art Unit: 2685

Regarding **claims 25, 30**, Mankovitz has taught above the means for storing at least a portion of said contextual information of the data signal along with musical selection (col. 2, lines 32-36).

Regarding **claim 27**, Mankovitz teaches the storing at least portion of contextual information onto a storage (multiple text message may be stored and recalled in col. col. 2, lines 32-42), the purchasing of the album at a later time (col. 2, lines 4-7). It is well known in the technology that the removable storage, cassette, can be used with FM radio receiver.

Regarding **claims 28, 29**, Mankovitz teaches the storing at least portion of contextual information onto a storage (multiple text message may be stored and recalled in col. col. 2, lines 32-42), the purchasing of the album at a later time (col. 2, lines 4-7). It is well known in the technology that the removable storage, cassette, can be used with FM radio receiver.

Mankovitz has taught above the means for storing at least a portion of said contextual information of the data signal (col. 2, lines 32-36).

Regarding **claim 31, 32**, Bernard teaches the accepting customer order, processing order to complete a sale of product (col. 64, lines 23-30; col. 65 lines 19-22), the sending order to customer (col. 14, line 53, provide items to customer 4420, Fig. 44) to fulfill the shipped of the product to complete the sales, based on the accepted order from customer via remote communication medium, for the order indicating one or more of plurality of media products that customer would like to purchase (col. 64, lines 23-300, the identifying product order (col. col. 64, lines 31-39), the determining of geographic location and album titles (col. 64, lines 40-51).

Art Unit: 2685

Regarding **claims 33, 34**, Bernard teaches the accepting customer order, processing order to complete a sale of product (col. 64, lines 23-30; col. 65 lines 19-22), the sending order to customer (col. 14, line 53, provide items to customer 4420, Fig. 44) to fulfill the shipped of the product to complete the sales.

2. Claims 14, 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Bernard, and further in view of Rovira et al. (US 5,239,540)

Regarding **claim 14**, Rovira has taught above the wireless communication link (col. 4, lines 1-8). Rovira teaches the transmitting and receiving digital audio program and transmitting combined signals via satellite to receiving system for listener or viewer (abstract, Fig. 1).

Rovira teaches an improved technique by providing displayed music program information to subscriber by transmitting program information combined with digital audio (col. 2, lines 5-29), including wireless means (col. 4, lines 1-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Mankovitz, and include Rovira's wireless communication means, such that the user could have the audio program information for purchasing audio program wirelessly.

Regarding **claim 20**, Rovira teaches the wireless transmitting above in claim 14.

3. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Bernard, as applied to claim 15 above, and further in view of Gordon et al. (US 6,314,573).

Regarding **claim 21**, Bernard taught above the transmitting at least a portion of contextual information to service provider with artist name, catalog number above.

Bernard does not clearly teach the receiving from service provider additional contextual information for audio program, Gordon teaches the subscription on demand services SOD for the interactive distribution system (title, abstract, summary of invention). Gordon teaches, in his claim 6, the sending from service provider to subscriber a first menu to display the menu on the graphical user interface (Fig. 8, Fig. 5). Gordon teaches the transmitting identified, selected, audio program in context information to service provider, and receiving from additional page for accepting offer (Fig. 7) in order to purchase a recording of audio program indicated, identified by the context information on display device, Gordon teaches (in his claim 6), the sending a selection signal indicating selected video-on-demand from subscriber to service provider. Gordon teaches the delivery packages ordered by customer from screen, including music videos, cooking, travel, automotive, education, children's program (col. 8, lines 46-59). Gordon teaches the interactive distribution system to distribute, ship, the recording packages from service provider to customer, based on the subscriber's interactive purchase order on-demand, after reviewed the price for the package on display, menu (abstract, summary of invention). Gordon teaches the techniques for package delivery from subscriber's purchase order on demand in a interactive way, to allow rapid navigating through the menu of the package to be ordered (first paragraph in summary of invention), such that the system could operate in a efficient way for the music video to be ordered, by using the interactive menu. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Mankovitz as modified above, and to include

Art Unit: 2685

Gordon's interactive package purchase to allow rapid menu navigating, such that the system could operate efficiently for purchasing the music video, by using the interactive menu.

Response to argument

4. Applicant's arguments with respect to claims 1-2, 5-7, 10, 13-17, 19-22, 24-25, 27-34 have been considered but are moot in view of the new ground(s) of rejection.

Regarding applicant's argument for the no teachings for the transmitting purchase order to service provider to purchase recorded audio programs, as indicated by the contextual information in the transmitting message from user, the ground of rejection has been changed to include Mankovitz (US RE37,131E) and Bernard et al. (US 5,918,213).

Bernard teaches the accepting customer order, processing order to complete a sale of product (col. 64, lines 23-30; col. 65 lines 19-22), the sending order to customer (col. 14, line 53, provide items to customer 4420, Fig. 44) to fulfill the shipped of the product to complete the sales, based on the accepted order from customer via remote communication medium for the order indicating one or more of plurality of media products that customer would like to purchase (col. 64, lines 23-30) for the identified product order (col. col. 64, lines 31-39) and to determine customer's geographic location for the order of the album titles (col. 64, lines 40-51).

In view of the cited references, claims 1-2, 5-7, 10, 13-17, 19-22, 24-25, 27-34, are remaining in the rejected manner.

Conclusion

Art Unit: 2685

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Chow whose telephone number is (703)-306-5615. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703)-305-4385.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D. C. 20231

Or Faxed to: (703)-872-9306 (for formal communications intended for entry)

Or hand-delivered to: Crystal Park 11, 2121 Crystal Drive, Arlington, VA, Sixth Floor, Receptionist. For general inquiry or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703)-306-0377.

Charles Chow *C.C.*

February 9, 2004.


EDWARD F. URBAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600